

*Initials
Cited
B3*

d) a database on the server computer containing accessorial service information; and

e) programs or software for sequentially displaying [at least on] a plurality of accessorial services and requiring the user to address each of said accessorial services offered and to accept or decline said accessorial services wherein said services comprise[s] [one] two or more of the following: arrival notification, construction site, inside delivery, liftgate service, residential delivery, residential pickup, and Saturday pickup.

REMARKS

Applicant believes that the §112 objection is resolved by the amendment made to claim1. In addition, the claims were rejected as being obvious under 35 U.S.C. §103 based on Hunt, Danford-Klein, and Laverly. Applicant respectfully disagrees with the rejection.

Central to the rejection was a finding by the Examiner that Laverly allegedly teaches the claim element which requires a user to accept or decline the accessorial services presented. More specifically, the Examiner found the following:

"Second, the notion of requiring a user to accept or decline is well known in the art of computer programming. Laverly, for example, teaches a system requiring user agreement before proceeding, and explicitly requiring the user to accept or decline the agreement (see page 1, 5th paragraph). The fact that the applicant applies this feature within the context

of accessorial services does not render it patentable over the prior art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply this accept/decline feature of Laverly to the system of Hunt et al. Since the basic concept (i.e., requiring a user to accept or decline an agreement before proceeding) is well known in the art, and since applying this feature to the case of accessorial services is simply a specific application of requiring a user to accept or decline information. The accept/decline feature, even though applied by applicant to a different type of information, does not in itself render the claim patentable over the prior art. Also, the fact that it is being applied in order to reduce errors in freight services and billing does not lend patentable weight, since this simply pertains to why the feature is applied, not what is actually done. "

However, even if Laverly is analogous art (which it is not for the reasons discussed below), it does not render Applicant's invention obvious. Laverly, in contrast to Applicant's invention, teaches how to impose a website's terms and conditions upon a user. Laverly says this may be done in a number of different ways. One way suggested is to make the term and conditions conspicuous. The other way is to require a user to select an acceptance button or a button rejecting the terms. If the terms are rejected, Laverly teaches that the user must leave the website:

"Require **user agreement** before proceeding. Common ways to get a **user to agree** to the terms of use include a button saying "I Agree" or a dialog box in which the **user must** type in his or her name. The **user** should also have the **explicit** options to reject the terms and leave the **Web** site, such a button saying, " I Do Not Agree." "

Thus, when the entire teaching of Laverly is considered, it becomes readily apparent that there is no suggestion, teaching, or motivation to combine the Laverly methodology with the teachings of Hunt or that, if applied, the claimed invention would result. This is so because Laverly teaches that once the "I Do Not Agree" button is activated, the user must leave the website. Applying this concept to shipping services would be disastrous. What would happen is that once an accessorial service is rejected, the user must leave the site. The only way for a user to continue processing a shipping transaction within the site would be to accept all accessorial services offered. While this may result in more business for the shipper, it is a system which is impractical for obvious reasons.

Nor may this teaching of Laverly be ignored. By law, a reference must be considered as a whole for everything it teaches. It is impermissible under §103 to pick and choose form a reference only so much of it as will support the Examiner's position, to the exclusion of other parts necessary to a full understanding of what the reference fairly would have suggested to one of ordinary skill. Bausch & Lomb, Inc. v. Barnes-Hind, Inc., 796

ATTORNEY DOCKET NO. 2799CIP

F.2d 443, 448, 230 U.S.P.Q. 416, 419 (Fed. Cir. 1986); In re Hedge, 783 F. 2d 1038, 1041, 228 U.S.P.Q. 685, 687 (Fed. Cir. 1986).

Equally important, the claims now indicate that a plurality of services are to be sequentially accepted or declined. Again, Laverly does not teach this element since Laverly's focus is on getting users to agree to the terms of a website -- a one time task that must be completed prior to entering the site.

The only place where a teaching is found that multiple accessorial services are to sequentially accepted or declined is in claim 1 and in Applicant's specification. Laverly certainly does not teach this. Thus, what has been done here is that Applicant's own teaching have been read into the teachings of Hunt.

As the Federal Circuit has held, that is legally wrong. Vandenberge v. Dairy Equipment Co., 740 F.2d 1560, 1564, 224 U.S.P.Q. 195, 197 (Fed. Cir. 1984). It is improper to use an inventor's patent application as an instruction book on how to reconstruct the prior art in hindsight:

a prior patent must be considered in its entirety, i.e., as a whole, including portions that would lead away from the invention in suit, elements of separate prior patents cannot be combined when there is no suggestion of such combination anywhere in those patents, and a court should avoid hindsight.

Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1568, 1 U.S.P.Q.2d 1593, 1597 (Fed. Cir. 1987) (citations omitted). Yet, only by making use of the "tempting but forbidden" process of hindsight (see Loctite Corp. v. Ultraseal Ltd., 781 F.2d 861, 873, 228 U.S.P.Q. 90, 99 (Fed. Cir. 1985)) can Applicant's invention be constructed from Laverly and Hunt.

To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 312-13 (Fed. Cir. 1983).

Lastly, Laverly is simply not analogous prior art. In order to cite a reference for purposes of showing obviousness, the Examiner must demonstrate that it is from the same field of endeavor or reasonably pertinent to the problem facing the inventor of the challenged patent. In re Clay, 966 F.2d 656, 658-59, 23 U.S.P.Q.2d 1058, 1060 (Fed. Cir. 1992). In Clay, the Federal Circuit held that a reference concerning the use of gel in underground petroleum reservoirs was not prior art to a patent application directed to the use of gel in aboveground petroleum storage tanks, even though both activities related to the petroleum industry. 966 F.2d at 659-60, 23 U.S.P.Q.2d at 1060-61. See also, In re Deminski, 796 F.2d 436, 442, 230 U.S.P.Q. 313, 315 (Fed. Cir. 1986) (reference must be within the field of the inventor's endeavor or at least reasonably pertinent to the particular problem with which the inventor was involved); A.J. Deer Co. v. U.S. Slicing Mach. Co., 21 F.2d 812, 813 (7th Cir. 1927) (device for cutting logs not analogous to device for slicing meat).

Here, the connection between Laverly and Applicant's invention is even more tenuous than in the foregoing cases. As stated above, Laverly deals with how to get users to abide by the terms of a website and if acceptance is not gained, the user must exit the

ATTORNEY DOCKET NO. 2799CIP

site. The claimed invention on the other hand is a system for reducing shipping errors caused by improper selection of accessorial services. The two systems could not be more different. A person of ordinary skill seeking to create Applicant's system would not have looked to systems for controlling access to websites to reduce errors commonly found in freight shipping services. The Examiner's reliance on Laverly, therefore, is misplaced.

For the reasons stated above, the claims should be found allowable once again.

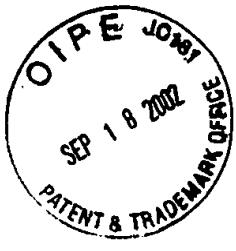
Respectfully submitted,



Keith A. Vogt
Reg. No. 37,252

NIRO SCAVONE HALLER & NIRO
181 W. Madison Street, Suite 4600
Chicago, Illinois 60602
(312) 236-0733

Dated: September 13, 2002



ATTORNEY DOCKET NO. 2799CIP

PROPOSED CLAIM CHANGES
(Marked Copy)
SERIAL NO. 09/557,822

1. (Once Amended) A computer based system for reducing user errors in ordering freight services [and billing] comprising:
 - a) a server computer;
 - b) a distributed network connected to the server computer;
 - c) a user computer connected to the distributed network which can interact with the server computer; [and]
 - d) a database on the server computer containing accessorial service information; and
 - e) programs or software for sequentially displaying [at least on] a plurality of accessorial services and requiring the user to address each of said accessorial services offered and to accept or decline said accessorial services wherein said services comprise[s] [one] two or more of the following: arrival notification, construction site, inside delivery, liftgate service, residential delivery, residential pickup, and Saturday pickup.